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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/920,608 08/27/97 PELLEYMOUNTER

M A-345-A

EXAMINER

18N2/0121

KAROL M PESSIN  
U S PATENT OPERATIONS/KMP  
M/S 10-1-B AMEGEN INC AMEGEN CENTER  
1840 DE HAVILLAND DRIVE  
THOUSAND OAKS CA 91320-1789

DRAPER, G

ART UNIT

PAPER NUMBER

1812

DATE MAILED: 01/21/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-12 are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. A telephone call was made to Karol Pessin on 1-20-98 to request an oral election to the above restriction requirement, but did not result in an election being made. Although this is a continuation application of 08/474833 in which the claims and the restriction are the same, Ms Pessin expressly requested a written restriction requirement.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of treating excess weight, classified in classes 424 and 514, subclasses 85.2 and 2+ respectively.
  - II. Claims 5-10, drawn to DNA encoding the Ob protein and vectors, classified in classes 536 and 435, subclasses 23.5 and 320.1 respectively.
  - III. Claims 11-12, drawn to a method of refolding a partially purified Ob protein, classified in class 530, subclass 351+.

The inventions are distinct, each from the other because:

Inventions Group II and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the DNA of Group II can be used other than to make the Ob protein such as its use in therapy or diagnostically. Furthermore, the protein can be made other than with the refolding method of Group III, such as its preparation from nature using various isolation/purification/ chromatographic processes; or it could be made by chemical synthesis.

It is further pointed out that inventions of Group I and III are directed to two different and distinct methods. Although there are no provisions under the section for "Relationship of inventions" in MPEP 806.05 for different/distinct processes /methods, restriction is deemed to be proper because these processes/methods appear to constitute patentably distinct inventions. These two methods require the use of physically and functionally distinct elements, different components and steps, as well as have different starting features and different final outcomes,


*checked by  
via phone*

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which are not required one for the other. The method of refolding the ob protein is quite distinct from a method of using the ob protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, which are not co-extensive, and because of the recognized divergent subject matter between the receptor and the methods of making and using the antibodies; there are different issues for the search and examination of each group; and in view of the grouping of multiple elements in Group I to satisfy the 371 practice, to search additional groups would be an undue burden on the Examiner, therefore, restriction for examination purposes as indicated is proper.

3. Any inquiry concerning this communication should be directed to Garnette Draper at telephone number (703) 308-4232.

  
GARNETTE D. DRAPER  
PRIMARY EXAMINER  
GROUP 1800